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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,111	04/13/2005	Jason Scott Sawyer	X-16040	4510
25885 7590 01/13/2009 ELI LILLY & COMPANY PATENT DIVISION P.O. BOX 6288 INDIANAPOLIS, IN 46206-6288				
EXAMINER COLEMAN, BRENDA LIBBY				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
01/13/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@lilly.com

### Office Action Summary

**Application No.**

10/531,111

**Applicant(s)**

SAWYER, JASON SCOTT

**Examiner**

Brenda L. Coleman

**Art Unit**

1624

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 6 and 7 is/are allowed.
- 6) ☒ Claim(s) 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claims 4-7 are pending in the application.

This action is in response to applicants' amendment filed October 10, 2008.

Claim 5 has been amended.

**Note: The applicants' are reminded of the manner of making amendments.**

37 CFR § 1.121 Manner of making amendments in application.

(c) Claims. Amendment to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an exiting claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims in the amendment document will serve to replace all prior versions of the claims in the application. In the claim listing, the **status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).**

**The following claim(s) fail to properly identify the status of the claims:**  
**claim 5 has been amended in the response filed October 10, 2008, but claim 5 indicates (Previously presented) after the claim number. Amended claims will not print properly if the status identifier is not properly stated, i.e. (Currently amended).**

### ***Response to Amendment***

Applicant's amendments filed October 10, 2008 have been fully considered with the following effect:

1. The applicants' are reminded that the amendments filed February 20, 2008 and April 18, 2008 have not been entered and thus the amendments to the specification with respect to the priority insert into the first line of the specification has not been entered.

2. The applicants' are reminded that the amendments filed February 20, 2008 and April 18, 2008 have not been entered and thus the amendments to the specification with respect to the title of the invention has not been entered.

3. The applicants' amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled 4c) of the last office action, which is hereby **withdrawn**. However, with regards to the 35 U.S.C. § 112, second paragraph rejection labeled a) and b) in the last office action, the applicant's amendments and remarks have been fully considered but they are not persuasive.

a) The applicants' failed to comment on the rejection of Claim 5 where periods are used throughout the claim. A period is used to end the claim or in some instances in the nomenclature of species thus the use of periods after the letters a, b, c and d are improper.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record and stated above.

b) The applicants' failed to comment on the rejection of Claim 5 where it was stated that it was not known what is meant by "[1,5a]" in the nomenclature of the

second species. It is believed that the applicants intended "[1,5-a]" as appears in the other three species.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record and stated above.

***Allowable Subject Matter***

4. Claims 4, 6 and 7 are allowed. None of the prior art of record or a search in the pertinent art area teaches the compounds, compositions and method of use of the compounds of formula III as claimed herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brenda L. Coleman/  
Primary Examiner, Art Unit 1624